

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):

Curry, et. al.

Serial No.: 09/683,995

Filed: 3/10/02

Title: Email messaging program with built-in video and/or audio media recording and/or playback capabilities

Attorney Docket No.: 1049.002US1

Group Art Unit:

2151

Examiner:

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APR 25 2003

Technology Center 2100

PETITION TO MAKE SPECIAL UNDER 37 C.F.R. 1.102

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is a Petition to Make Special the above-identified patent application. The basis for this petition is actual infringement.

In accordance with this Petition, seven (7) pages of support information are attached hereto, as signed for by Applicant's Attorney.

Payment of the Petition fee of \$130 is made by credit card via the attached Form PTO-2038.

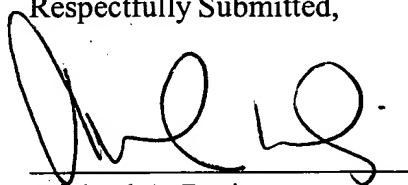
In view of the above, Applicant requests that the Petition to Make Special be granted and the examination of the application be advanced.

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Respectfully Submitted,



Michael A. Dryja
Registered Patent Attorney

Michael A. Dryja
Registered Patent Attorney
704 228th Avenue NE
PMB 694
Sammamish, WA 98074
Tel. 425-427-5094

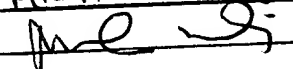
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MICHAEL DRYJA

printed name



signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant(s): Curry et al.

Application No.: 09/683,995 (CONF 2530)

Filed: 3/10/2002

Title: Email messaging program with built-in video and/or audio media recording and/or playback capabilities

Attorney Docket No.: 1049.002US1

Group Art Unit:
2151

Examiner:

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Assistant Commissioner for Patents
Washington, D.C. 20231

SUPPORTING INFORMATION TO PETITION TO MAKE SPECIAL

Dear Sir:

The following remarks are presented as supporting information to the petition to make special filed herewith, in accordance with 37 CFR 1.102. The basis for the petition to make special is in accordance with MPEP section 708.02, II, that the application be made special because of actual infringement. These remarks are organized in accordance with the lettered headings (A)-(C) of MPEP section 708.02, II, and the lettered headings (A)-(E) of MPEP section 708.02, VIII.

708.02, II.(A)

Applicant's attorney alleges, based upon information and belief, that there is an infringing device or product actually on the market, or method in use, of at least some of the claims of the patent application in question. This infringing product is identified as ConnectMail Video Messaging, available from ConnectMail, Ltd., of Cincinnati, Ohio. Information regarding ConnectMail Video Messaging is available at the Internet web site www.ConnectMail.com. Selected web pages from this web site have been printed off by Applicant's attorney, and are attached hereto as Exhibit 1.

708.02, II.(B)

Applicant's attorney alleges, based upon information and belief, that a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that in his opinion, some of the claims are unquestionably infringed. The following claim chart of claim 8 is provided as an example of this allegation.

Claim limitation or element following the preamble "A system comprising:"	Corresponding infringement by ConnectMail Video Messaging, as taken from the web pages of Exhibit 1
"a networking mechanism communicatively coupling the system to a network; and,"	ConnectMail Video Messaging "takes the tool you prefer – email – and adds video and audio capabilities without taking anything away." It is compatible with Microsoft Outlook 98/2000 and Lotus Notes version R5. As such, the ConnectMail Video Messaging, as integrated with Microsoft Outlook or Lotus Notes, allows for emails to be sent and receive with audio and video. Because emails are sent and received over the Internet, the ConnectMail Video Messaging system inherently includes a networking mechanism, such as an Ethernet card, a modem, etc., to connect to the Internet, so that email can be sent and received over the Internet.
"an email messaging program having at least a composing capability for a user to compose a message and record media associated with the message to send to another user over the network via the networking mechanism."	ConnectMail Video Messaging is "completely integrated" and "is integrated into many of the email and other messaging services and software packages that you use on a regular basis." It allows a user to "send messages that include full-motion video and audio ..., audio only, and text messages." The product allows a user to "just point, click, record and send. Review your message before sending if you want to see what it looks and sounds like." It has the "ability to record messages in video or audio only format," the "ability to send combined text and media messages," and the "ability to send messages internal and external to [an] organization." As combined with Outlook or Notes, ConnectMail has a composing capability for a user to compose a message (i.e., an email), and record media (i.e., audio and/or video) associated with the message to send to another user.

708.02, II.(C)

Applicant's attorney alleges, based upon information and belief, that a careful and thorough search of the prior art has been made, and/or that Applicant has a good knowledge of the pertinent prior art. Details regarding the prior art search and the prior art are provided below, in conjunction with 708.02, VIII.(C), (D), and (E).

708.02, VIII.(A)

Applicant's attorney has submitted herewith a petition to make special, accompanied by the fee set forth in 37 CFR 1.17(h).

708.02, VIII.(B)

Applicant's attorney presents all the claims, 1-24, in the pending patent application in question, as filed, as being directed to a single invention. These claims are not duplicated here. Applicant's attorney therefore asserts that no election of claims is necessary. However, in the alternative, Applicant's attorney provides the Patent & Trademark Office as suggestive guidance that claims 8-17 be elected should the Office determine such election be necessary.

708.02, VIII.(C)

Applicant's attorney submits that a careful and thorough pre-examination search has been made. Applicant's attorney conducted a keyword prior art search of both domestic and foreign issued patents and published patent applications, utilizing the subscription patent document search engine service Delphion, available at the Internet web site, www.Delphion.com. Specifically, prior art was searched for that related to video email. Within the prior art that was then found, prior art was searched for in which there is a program that can both send and receive email, and that has built-in functionality to record/send and play/receive video email, although no such latter prior art was specifically found.

In addition, Applicant's attorney received from Applicant the results of a previous prior art search conducted by Applicant's previous counsel before retaining current counsel. An outside search agent conducted this prior art search. Finally, Applicant has a good knowledge of the pertinent prior art, and provided Applicant's attorney with additional prior art references that were not found in Applicant's attorney's own search or in Applicant's previous counsel's search. All of the prior art references that have been discovered have previously been submitted via the Information Disclosure Statement (IDS) deposited by First Class Mail on March 16, 2002, via the supplemental IDS filed electronically on August 15, 2002, and via the supplemental IDS deposited by First Class Mail on August 16, 2002.

708.02, VIII.(D)

By information and belief, Applicant's attorney alleges that the most closely related prior art references are: Budge et al., US Pat. No. 6,014,689; Venkatraman et al., US Pat. No. 6,014,688; Fardella et al., US Published Pat. App. No. 2001/003,2246; and, Walters et al., US Published Pat. App. No. 2001/005,2019. It is noted that all four of these references are already on record. The Budge and Venkatraman references were submitted in the IDS deposited on March 16, 2002, whereas the Fardella and Walters references were submitted in the supplemental IDS filed electronically on August 15, 2002.

708.02, VIII.(E)

Applicant's attorney now provides a detailed discussion of the references identified above, which discussion points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references. Applicant notes that there are three independent claims pending, claims 1, 8, 18, and 22. For the purposes of this discussion, claim 8 is treated as exemplary of the independent claims, such that claims 1, 18, and 22 are patentable for at least the same reasons that claim 8 is patentable. Claim 8 is limited to a system that includes "an email messaging program having at least a composing capability for a user to

compose a message and record media associated with the message to send to another user.” The message is thus an email, and the media may be audio and/or video. The remaining claims ultimately depend off one of the independent claims 1, 8, 18, and 22, and are therefore patentable for at least the same reasons that claims 1, 8, 18, and 22 are.

None of the references, either alone or in combination, anticipate or render obvious the claimed subject matter. That is, none of the references, either alone or in combination, anticipate or render obvious a system that includes an email messaging program having at least a composing capability for a user to compose a message and record media associated with the message to send to another user over the network via the networking mechanism. Specifically, neither the Budge reference, the Venkatraman reference, the Fardella reference, nor the Walters reference, either alone or in combination anticipate or render obvious the claimed subject matter.

Specifically with respect to Budge, a video e-mail recorder 210 is disclosed (FIG. 3, col. 4, ll. 42 et seq.) with which video e-mail is recorded. However, the “video e-mail recorder 210 . . . executes the Email client 270 and passes the video e-mail file to the Email client 270.” (Col. 4, ll. 33-35) Neither the video e-mail recorder 210, nor the email client 270, by itself has a composing capability for a user to compose a message *and* record media associated with the message to send to another user, as to which the claimed invention is limited. The recorder 210 does the latter, whereas the email client 270 does the former. Neither program does both; they are separate programs. Budge, either alone or in combination with any of the other references, therefore does not anticipate nor render obvious the claimed invention.

With respect to Venkatraman, creation software is used to generate an email that includes audio or video. (Abstract) To send and receive the email, however, Venkatraman relies upon an “e-mail platform.” (Col. 1, ll. 52-55) Like the e-mail recorder and the email client in Budge, neither the creation software of Venkatraman, nor the e-mail platform of Venkatraman, by itself has a composing capability for a user to compose a message *and* record media associated with the message to send to another user, as to which the claimed invention is limited. The creation software does the latter, whereas the e-mail platform does the former. Neither program does

both; they are separate programs. Venkatraman, either alone or in combination with any of the other references, does not anticipate nor render obvious the claimed invention.

With respect to Fardella, a user composes a video email, and a message – different from the video email – is sent to a central server. (Para. 0007) The server sends the user an email message with a message number to be associated with the video email, and the user uploads the video email to the central server. (*Id.*) “At this point, the *central server* would e-mail a message to the receiver, notifying the receiver of the existence of the video e-mail.” (*Id.*) (Emphasis added) When the receiver wishes to view the video, “a connection is made between the central server and the receiver’s personal computer, thereby allowing the video message to be viewed through a web browser provided on the receiver’s personal computer.” (*Id.*) However, the software in Fardella that composes the video email does not do so “to send to another user,” as to which the claimed invention is limited. Rather, the composing software in Fardella merely uploads the video email to a central server. The *central server*, not the composing software, then emails a *different* message to the receiver to pick up the video e-mail, by connecting to the central server without using an email messaging program. Fardella, either alone or in combination with any of the other references, therefore does not anticipate nor render obvious the claimed invention.

With respect to Walters, a user composes a video mail file containing audio and video content, and the video mail file is sent to a video store, or server. (Abstract) Like the central server in Fardella, the *video store* then sends only an electronic text message and a hyperlink to the video mail file on the video server to the recipient. (Abstract, FIG. 1) When the user opens the electronic text message, he or she clicks on the hyperlink “to have the selected video file streamed from the video server to the receiver computer, where it is viewed.” (Abstract) Thus, like the composing software in Fardella, the software in Walters that composes the video mail file does not do so “to send to another user,” as to which the claimed invention is limited. Rather, the composing software in Walters merely uploads the video mail file to a video server. The *video server*, not the composing software, then sends an electronic text message and a

Law Offices of Michael Dryja
704 228th Ave NE #694
Sammamish, WA 98074
tel: 425-427-5094
fax: 206-374-2819



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ConnectMail Video Messaging

ConnectMail: The Future of Email....Today

"By 2005, video email will replace text messages as the main online communication mechanism. Text-based email will seem as archaic as black-and-white TV."

- Jeremy Schwartz
Senior Analyst Media & Entertainment
Forrester Research

Today, email is the communication tool of choice, surpassing the telephone. Yet, anyone that uses email knows that there are limitations to communicating with text-based messaging systems – it was not the way humans were meant to communicate effectively. With text, what you mean is not always the message that is received. For example:

- ✗ Non-verbal communication (body language) comprises over 80% of communication, and is impossible to express using text
- ✗ Tone, emotion, and sarcasm are often miscommunicated in text
- ✗ Many people simply do not feel comfortable expressing themselves "through their fingers" on a keyboard




Say More, Type Less with ConnectMail

ConnectMail takes the tool you prefer – email – and adds full-motion video and audio capabilities without taking anything away. You don't have to change the email client

Products

ConnectMail's offering consists of three unique products:

- ConnectMail for Microsoft Outlook
- ConnectMail for Lotus Notes
- ConnectMail for Openwave MX
- ConnectMail SDK (Software Development Kit) for customized implementations of other web-based email and messaging systems (available to authorized resellers only)



[Outlook](#)[Notes](#)

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EXHIBIT 1

you like, the email provider you like or even the bandwidth connection you have. Yes, it works on the computers widely in use today -- with the email systems widely in use today like webmail, Microsoft Outlook? and Lotus Notes? . No waiting for the telephone provider to provide the latest high speed connections. No expensive new hardware to purchase (it works with even low end webcams).

Nothing changes.....except your ability to express yourself more easily than before.

So you can go back to more personalized and natural communications with family, friends, employees, customers, suppliers and prospects -- through email. Click in the box to the right to view sample uses of ConnectMail and judge the difference for yourself.

Sample Uses

Want To See Some?

ConnectMail Video Messages can really change the impact of your email. Click [HERE](#) to experience what it's like to receive a ConnectMail Video email.

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Client Software

- ✗ Compatible with Outlook 98/2000 and with Notes version R5
- ✗ Completely integrated, easy to install Outlook form
- ✗ Ability to record messages in video or audio only format
- ✗ Compatible with variety of web camera hardware
- ✗ Easy to use interface, including VCR-like buttons
- ✗ Ability to send messages internal and external to organization
- ✗ Ability to send combined text and media messages
- ✗ Access to all current functionality of email client including: address book, reply/forward
- ✗ Ability to save media messages to local drives
- ✗ Complete end user documentation

Server Software

- ✗ Comes complete with variety of supporting software including: Windows Media Services, Apache 3.12, Mod Perl, SendMail, Samba,
- ✗ FTP software, MySQL and Access Components, WebMin, PHP Admin, and more...
- ✗ Quality playback over 28.8 connections
- ✗ Complete control over video quality with admin tools
- ✗ Web-based end user help
- ✗ Installation Guide including Planning Guide
- ✗ Admin. Guide
- ✗ Configuration tools

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ConnectMail vs. Email

Think of ConnectMail as your email on steroids. ConnectMail video messaging lets you do and say a whole lot more than you can with just your basic, everyday email software. In the coming months, you'll find ConnectMail integrated into many of the email and other messaging services and software packages that you use on a regular basis. In the meantime, read more about what ConnectMail can do for you below, or sign up to try ConnectMail right now, for FREE, and experience how it can make your communication more personal, dynamic and fun.

What's in it for Me?

ConnectMail gives you more choices to communicate in the right way at the right time.

- Send messages that include full-motion video and audio (just as if you recorded yourself on videotape to be played in a VCR), audio only, and text messages (like conventional email). You can even add file attachments, such as digital photos, word processing documents or sound files.
- Connect with your family while away on a business trip, record messages that allow grandchildren miles away to see and hear you, or check in with mom and dad while you're away at school.

ConnectMail makes communicating easier and more natural.

- ✧ Just point, click, record and send. Review your message before sending if you want to see what it looks and sounds like. Re-record as many times as you like. You're in control.
- ✧ Using ConnectMail will seem like a familiar experience – buttons are similar to using a VCR or tape recorder. Consequently, there's no lengthy user's manual to wade through.
- ✧ You no longer have to express yourself through your computer keyboard alone. Now friends, family and business associates can see and hear you right from their computer screen by viewing streaming ConnectMail video.

ConnectMail has many advantages over other PC video products.

- ✧ ConnectMail works with many types of PC cameras including Logitech™, 3Com™, Intel™, IBM™, Kodak™, and Philips™ brand cameras. Click [HERE](#) to get \$10 off a Logitech™ Webcam Now!
- ✧ Recipients of your ConnectMail messages don't have to endure long downloads - videos are in streaming format and are viewed on the Web, not as an attachment to email. Because videos reside on ConnectMail servers, your recipients also don't have to worry about dreaded viruses.
- ✧ Storage and software running on ConnectMail servers also means that you and your recipients won't have to deal with personal computers getting clogged up with large multimedia or program files.

With ConnectMail, you now have the power to "say more, type less." Click [HERE](#) for a free trial of ConnectMail video messaging.

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